

REMARKS/ARGUMENTS

This Amendment and Response is promptly filed to place the above-referenced case in condition for immediate allowance.

The status of the claims is as follows:

<u>Cancelled:</u>	9, 10, 12 - 29, 40, 41, 43 - 70, 81, 87, 91, 97, and 100 - 105;;
<u>Amended:</u>	1, 4, 11, 33, 36, 42, 76 - 80, 82 - 86, 88 - 90, 92, 94 - 96, 98, 106 - 107, and 113 - 114;
<u>Added:</u>	None; and
<u>Currently outstanding:</u>	1 - 8, 11, 30 - 39, 42, 71 - 80, 82 - 86, 88 - 90, 92 - 96, 98 - 99, and 106 - 119.

No new matter has been added to the application.

The claims presented herein preliminarily amend those submitted previously with the Request for Continued Examination (RCE).

Reconsideration is respectfully requested.

Applicant has amended the claims to better reflect the claimed subject matter. No narrowing amendment to conform with statute has been made in the application by the amendments to the claims.

The following arguments were set forth previously in the Amendment accompanying the RCE. They are set forth below as appropriate for the claims, above, and for the purposes of convenience.

Applicant believes that there is no suggestion, motivation, or teaching in either or both of the Huxter (2002/0103653) and/or Moreno (6,882,269) references to justify their

combination. As set forth in greater detail below, such a reason to combine the references is necessary even if the references show all the elements in an applicant's claims.

In this case, the combination of the Huxter and Moreno references does not even to that as neither reference discloses identification by the system of the commuting route or an overlap between routes. In the Huxter reference, it is the customer (and not the system) which provides and selects such information, particularly the pickup points (or, in the vocabulary of Huxter, the ACP sites) . Further, in Huxter, there is no realization of the economies provided by having shared pickup points between commuting routes. All of pickup points in the Huxter system are independent of each other, increasing the cost of product distribution.

As such, even if Huxter and Moreno are allowed to combine, the combination still misses a number of elements and/or features that are disclosed in the Applicant's specification. These elements have been included in the applicant's independent claims and/or dependent claims.

As set forth in Applicant's amended independent claims 1, 11, 33 and 42 such features/elements include the following: identifying a commuting route of a buyer by selecting at least one commuting route parameter and receiving from the buyer commuting route information, the commuting route information including a beginning address and an ending address; the server calculating a commuting route based on the selected commuting route parameter, the commuting route connecting the beginning address and the ending address; and selecting a pickup point along the identified commuting route.

Huxter never discloses the calculation of a commuting route of a buyer by the server based on route information received from a buyer and at least one selected parameter, the route

information includes a beginning address and an ending address. Nor does Huxter disclose “the selection of a pick up point along the identified commuting route” as described in the applicant’s amended claims.

Additionally, no such teaching is ever disclosed in Moreno.

Therefore, the Applicant’s independent claims, including claims 1, 11, 33 and 42 as amended, should be able to overcome the Huxter and Moreno references.

Furthermore, in Applicant’s claims, a mobile pick up station is loaded with a user’s order and then is dispatched to the pick up point with the order loaded. The mobile pick up station stays at the pick up point waiting for pick up for the user, his representative, or other users/representatives who have orders loaded.

Contrastingly, in Moreno, a movable locker, e.g., a shipping container or U-Haul vehicle/trailer, is moved to a designated address for on-site storage of goods (see Moreno col. 5 lines 1-10). The movable locker in Moreno is not a transportation facility, but a storage facility only. That is, in Moreno, a buyer order is transported by other transportation means to the pickup site and the order is then loaded to the locker.

By contrast, in Applicant’s model, a typical mobile pick up station is loaded with the user’s order in the seller’s warehouse. The mobile pick up station then carries the user order to a pick up point and stays at the pick up point waiting for buyer to pick it up. It is a transportation facility as well as a storage facility.

Applicant’s model is much more efficient than the systems set forth in either or both Huxter and Moreno because an order may be packed in the mobile pick up station and shipped directly to the pick up point. The mobile pick up station then stays at the pick up point waiting

for pick up. The extra step to load the order to a storage facility is not needed. No such teaching of Applicant's mobile pick up station is disclosed in either Huxter's or Moreno's patent, either taken separately or together.

Neither Huxter nor Moreno invention disclosed such teachings or elements present included Applicant's disclosure and included in the dependent claims, as amended. Such missing elements from Huxter and Moreno are: determining a station time, the mobile pickup station staying at a selected pick up point for the entire station time, so that a buyer may come to the pick up station any time during the station time to pick up the order; the mobile pick up station departing from the pick up point after the station time is over; and the station time optionally ending when the buyer picks up the order.

Furthermore, neither Huxter nor Moreno disclose: the overlapping of at least one of other user commuting routes; generating an overlapped segment of these travel routes; and selecting a pickup point along the overlapped route segment.

The foregoing arguments are believed to apply to all of Applicant's claims such that the Huxter and Moreno references (taken either separately or together in any reasonable combination) are believed to anticipate or make obvious any of Applicant's claims.

As set forth above, no new matter was added to the application with the amendments made to the claims as the subject matter is disclosed in the original specification.

In combining references, the publications must both disclose the elements in an applicant's rejected claims as well as providing a sufficient reason why such combination is to be made. The authority set forth below is believed to be relevant in the determination of

obviousness and the conclusion that Applicant's claims as amended are not made obvious by the combination of the Huxter and Moreno references.

From the foregoing, it can be seen that Applicant believes that there are a plurality of grounds upon which a rejection to the claims would be and is overcome. Applicant also believes that, for similar reasons, there is no teaching or motivation to combine the Huxter reference with the Moreno reference. In the recent past, the Court of Appeals for the Federal Circuit has spoken on this matter.

The Court of Appeals for the Federal Circuit (CAFC) has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. In the present case, there is no disclosure or suggestion in any of the references relied on by the Examiner from which the Mobile Pick Up Station system claimed by Applicant may be constructed. Indeed, even in light of Applicant's own teaching, the Examiner has been unable to reconstruct from the cited references a Mobile Pick Up Station system which meets the language of the present claims.

The Examiner cannot, in the absence of some suggestion or teaching in the references, simply combine references in an attempt to show that an applicant's claims are obvious. Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988). The CAFC has indicated that two questions are to be asked when a combination of references is relied upon to reject a claim:

- (1) whether a combination of the teachings of the references would have suggested (expressly or by implication) the possibility

of achieving further improvement along the lines of the claimed invention; and

(2) whether the claimed invention has achieved more than a combination which any or all of the prior art references suggested.

In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983).

The Court emphasized that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining these teachings. Something more than merely finding each element of the combination in the references is required, and here the Examiner has not even found that.

Applicant submits the Examiner has failed to demonstrate that the answer to either question should be decided against Applicant. None of the references, alone or in combination, disclose or suggest the combination of elements recited in Applicant's present claims. As such, Applicant's claims all go beyond that which has been achieved before and are not reflected by any reasonable combination of the prior art references.

Further, the Examiner has pointed to nothing in any of the references that suggests combining their teachings. A reading of each of the references uncovers no suggestion or teaching in any of them as to the advantages to be gained by having a mobile pickup station operating in efficient travel for a plurality of buyers/users as only an online retail delivery system is disclosed by Huxter while Moreno only discloses a locker system. The Examiner has unsuccessfully tried to pull from the cited references specific elements claimed by

Applicant, based on Applicant's own teaching and not on those teachings set forth in the cited references.

Finally, the subject matter of the invention as a whole must be considered. Even though features may be disclosed in the prior art, performing their ordained and expected function, the test is whether the claimed invention as a whole, in light of all of the teaching of the references in their entireties, would have been obvious to one of ordinary skill in the art. Connell v. Sears, Roebuck & Co., 722 F.2d 1542; 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983). Thus, it is clear that, in light of decisions of the CAFC, the Examiner has not met the CAFC's tests in combining references.

A reference is only good for what it clearly and definitely discloses. In re Moreton, 288 F.2d 708, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961); In re Hughes, 345 F.2d 184, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965). Furthermore, a patent is not a fair reference where it is not directed to the same purpose and does not involve the same inventive concept. Ex parte Garvey, 41 U.S.P.Q. 583 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1939). Absent a clear disclosure, i.e., an anticipation or some other special statutory prohibition, a rejection must stand or fall on the existence of obviousness as qualified in 35 U.S.C. § 103. In re Murray et al., 268 F.2d 226, 122 U.S.P.Q. 364, 367 (C.C.P.A. 1959).

It is submitted that the claims under discussion are not anticipated or obvious in view of the references made of record and the references relied upon by the Examiner in the rejections. The claims patently define over each of the references, either individually or taken in any reasonable combination.

A combination of references is improperly applied where there is no suggestion by any of the references of the problem involved or where the solution to the problem is neither indicated nor taught. In re Shaffer, 229 F.2d 476, 108 U.S.P.Q. 326, 329 (C.C.P.A. 1956). When references are combined, it should be considered whether the references suggest a thing which the applicant has done. In re Gruskin, 234 F.2d 493, 110 U.S.P.Q. 288, 292 (C.C.P.A. 1956). Moreover, references may not be combined where there is no suggestion in either of the references that they can be combined to meet the recitation of the applicant's claims. In re Hortman, 264 F.2d 911, 121 U.S.P.Q. 218, 220 (C.C.P.A. 1959); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); see also Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988).

Whether a combination of references negates patentability depends solely upon what the references would reasonably and realistically teach those of ordinary skill in the art. In re Free, 329 F.2d 998, 141 U.S.P.Q. 238, 240 (C.C.P.A. 1964); In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). What the Examiner is attempting is a piecemeal construction of the prior art in view of the Applicant's own disclosure in order to negate the present invention. The law clearly does not sanction this procedure. In re Rothermel et al., 276 F.2d 393, 125 U.S.P.Q. 328, 331 (C.C.P.A. 1960); In re Kamm & Young, 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972); W. L. Gore & Assoc. v. Garlock, 721 F.2d 1540; 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

As the CAFC has stated in Environmental Designs, Ltd. et al. v. Union Oil of Cal. et al.;

"Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art"

713 F.2d 693, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983), cert. denied, 104 S. Ct. 709, 224 U.S.P.Q. 520 (1984).

The CAFC has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. There is no teaching or suggestion in either the Huxter or Moreno references relied on by the Examiner from which the invention claimed by Applicant can be constructed. In In re Newell, 891 F.2d 899, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989) the Federal Circuit Court stated:

. . . a retrospective view of inherency is not a substitute for some teaching or suggestion [in prior art] which supports selection and use of the various elements in particular claimed combination. . . . It is well established that in deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art.

See also, accord, In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

From the foregoing remarks, Applicant's claims are all believed to be patentable over Huxter in view of Moreno.

The Examiner has also cited a number of patents and publications as pertinent to the presently claimed invention. Since none of these have been relied upon as a reference against Applicant's claims, no further comment is deemed necessary.

In view of the above, the Examiner is respectfully requested to reconsider her position in view of the remarks made herein and the structural distinctions now set forth. It is now believed that this application has been placed in condition for allowance, and such action is respectfully requested. Prompt and favorable action on the merits is earnestly solicited.

The Manual of Patent Examining Procedure (MPEP) § 2143.03 requires that all claim limitations be taught or suggested. As set forth above, the server's identification of the commuting route, among the other listed items, goes beyond what is disclosed in either Huxter or Moreno.

The Manual of Patent Examining Procedure (MPEP), particularly § 2143.01, requires that a suggestion or motivation must be present in order to combine references for purposes of obviousness.

Importantly, the prior art must suggest the desirability of the claimed invention.

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the

suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” In re Linter, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In Ruiz v. A.B. Chance Co., 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004), the patent claimed underpinning a slumping building foundation using a screw anchor attached to the foundation by a metal bracket. One prior art reference taught a screw anchor with a

concrete bracket, and a second prior art reference disclosed a pier anchor with a metal bracket. The court found motivation to combine the references to arrive at the claimed invention in the “nature of the problem to be solved” because each reference was directed “to precisely the same problem of underpinning slumping foundations.” Id. at 1276, 69 USPQ2d at 1690. The court also rejected the notion that “an express written motivation to combine must appear in prior art references....” Id. at 1276, 69 USPQ2d at 1690. However, it is apparent in Ruiz that a motivation to combine must still be present.

In In re Kotzab, the claims were drawn to an injection molding method using a single temperature sensor to control a plurality of flow control valves. The primary reference disclosed a multizone device having multiple sensors, each of which controlled an associated flow control valve, and also taught that one system may be used to control a number of valves. The court found that there was insufficient evidence to show that one system was the same as one sensor. While the control of multiple valves by a single sensor rather than by multiple sensors was a “technologically simple concept,” there was no finding “as to the specific understanding or principle within the knowledge of the skilled artisan” that would have provided the motivation to use a single sensor as the system to control more than one valve. 217 F.3d at 1371, 55 USPQ2d at 1318.

In In re Fine, the claims were directed to a system for detecting and measuring minute quantities on nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide detector. The primary reference disclosed a system for monitoring sulfur compounds comprising a chromatograph, combustion means, and a detector, and the secondary reference taught nitric oxide detectors.

The examiner and Board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was no support or explanation of this conclusion and reversed.

In In re Jones, the claimed invention was the 2-(2 α -aminoethoxy) ethanol salt of dicamba, a compound with herbicidal activity. The primary reference disclosed inter alia the substituted ammonium salts of dicamba as herbicides, however the reference did not specifically teach the claimed salt. Secondary references teaching the amine portion of the salt were directed to shampoo additives and a byproduct of the production of morpholine. The court found there was no suggestion to combine these references to arrive at the claimed invention.

Also, where the teachings of the prior art conflict, the examiner must weigh the suggestive power of each reference.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. In re Young, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991) (Prior art patent to Carlisle disclosed controlling and minimizing bubble oscillation for chemical explosives used in marine seismic exploration by spacing seismic sources close enough to allow the bubbles to intersect before reaching their maximum radius so the secondary pressure pulse was reduced. An article published several years later by Knudsen

opined that the Carlisle technique does not yield appreciable improvement in bubble oscillation suppression. However, the article did not test the Carlisle technique under comparable conditions because Knudsen did not use Carlisle's spacing or seismic source. Furthermore, where the Knudsen model most closely approximated the patent technique there was a 30% reduction of the secondary pressure pulse. On these facts, the court found that the Knudsen article would not have deterred one of ordinary skill in the art from using the Carlisle patent teachings.).

The fact that references can be combined or modified is not sufficient to establish prima facie obviousness.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness.

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

The proposed modification cannot render the prior art unsatisfactory for its intended purpose.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught

a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

Although statements limiting the function or capability of a prior art device require fair consideration, simplicity of the prior art is rarely a characteristic that weighs against obviousness of a more complicated device with added function.” In re Dance, 160 F.3d 1339, 1344, 48 USPQ2d 1635, 1638 (Fed. Cir. 1998) (Court held that claimed catheter for removing obstruction in blood vessels would have been obvious in view of a first reference which taught all of the claimed elements except for a “means for recovering fluid and debris” in combination with a second reference describing a catheter including that means. The court agreed that the first reference, which stressed simplicity of structure and taught emulsification of the debris, did not teach away from the addition of a channel for the recovery of the debris.).

The proposed modification cannot change the principle of operation of a reference.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are

not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” 270 F.2d at 813, 123 USPQ at 352.).

Lastly, the Court of Appeals for the Federal Circuit has made clear that hindsight reconstruction cannot be used to reject a claim and that the Examiner must show the teaching or motivation to combine prior art references. In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In reversing both the Board and the Examiner in their rejection of the claims, the Dembiczak Court made clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“the Board must identify specifically . . . the reasons one of ordinary skill in the

art would have been motivated to select the references and combine them”); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court’s conclusion of obviousness was error when it “did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination”). See also Graham v. John Deere, 383 U.S. at 18, 148 USPQ at 467 (“strict observance” of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”). In the Dembiczak case, above, the Board fell into the hindsight trap.

The Dembiczak court noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although “the suggestion more often comes from the

teachings of the pertinent references,” Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) (“Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.”); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) (“The examiner’s conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection.”). In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. In Dembiczak, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references.

As in the examination proceedings in Dembiczak, the Examiner has fallen into the insidious trap of hindsight reconstruction and has found no motivation or teaching for combining the references.

In In re Dembiczak, the applicants claimed a large, orange plastic trash bag decorated with a jack-o'-lantern face. The PTO rejected the claims as prima facie obvious based on prior

art references showing (1) conventional trash bags, and (2) "children's art" with jack-o'-lantern faces on the outside of paper sacks (Holiday and Shapiro). The court reversed because the PTO's broad conclusory statements regarding the teaching of multiple references, standing alone, were not "actual evidence" supporting a suggestion to combine.

"All the obviousness rejections affirmed by the Board resulted from a combination of prior art references, e.g., the conventional trash or yard bags, and the Holiday and Shapiro publications teaching the construction of decorated paper bags. ... To justify this combination, the Board simply stated that 'the Holiday and Shapiro references would have suggested the application of ... facial indicia to the prior art plastic trash bags. ... However, rather than pointing to specific information in Holiday or Shapiro that suggest the combination with the conventional bags, the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other--in combination with each other and the conventional trash bags--described all of the limitations of the pending claims. ... Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific--or even inferential--findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis.

"To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. For example, the Board finds that the Holiday bag reference depicts a 'premanufactured orange' bag material, ... finds that Shapiro teaches the use of paper bags in various sizes, including 'large', ... and concludes that the substitution of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an obvious **design choice**. ... Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. See Rouffet ... (noting Board's failure to explain, when analyzing the prior art, 'what specific understanding or technical principle ... would have suggested the combination'). Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand."

175 F.3d at 1000, 50 USPQ2d at 1617-18 (emphasis added).

The Examiner has also cited a number of patents and publications as pertinent to the presently claimed invention. Since none of these have been relied upon as a reference against Applicant's claims, no further comment is deemed necessary.

In response to the Examiner's comments regarding allowable subject matter in the present application, of September 21, 2005, at this time, Applicant neither agrees nor disagrees with the Examiner's comments as Applicant believes that such claims are patentable as they currently stand, and are the best recitation of the scope of allowable protection.

In view of the above, the Examiner is respectfully requested to reconsider her position in view of the remarks made herein and the structural distinctions now set forth. The Examiner's rejections of the outstanding claims are believed to no longer apply. It is now believed that this application has been placed in condition for allowance, and such action is respectfully requested. Prompt and favorable action on the merits is earnestly solicited. Applicant's respectfully requests that a timely Notice of Allowance be issued in this case.

The statements made herein with respect to the disclosures in the cited references represent the present opinions of the undersigned attorney. In the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective references providing the basis for a contrary view.

In view of the above, the Examiner is respectfully requested to reconsider her position in view of the remarks made herein and the structural distinctions now set forth. The Examiner's rejections of the outstanding claims are believed to no longer apply. It is now believed that this application has been placed in condition for allowance, and such action is

respectfully requested. Prompt and favorable action on the merits is earnestly solicited.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The statements made herein with respect to the disclosures in the cited references represent the present opinions of the undersigned attorney. In the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective references providing the basis for a contrary view.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at the number listed below.

With the above-referenced changes, it is believed that the application is in a condition for allowance; and Applicant respectfully requests the Examiner to pass the application on to

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January 10, 2006